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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

FULLER, ROBERT EDWARD

ART UNIT	PAPER NUMBER
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3672

DATE MAILED: 07/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/786,573	Applicant(s) ROGERS ET AL.	
	Examiner Robert E. Fuller	Art Unit 3672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-7, 9, 10, 12, 13, 15-18, 20, 21, 23-27, 30, 32-34 and 36 is/are rejected.
- 7) ☒ Claim(s) 3, 8, 11, 14, 19, 22, 28, 29, 31 and 35 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 4, 5, 7, 9, 10, 12, 13, 16-18, 20, 21, 23-25, 27, 30, 33, and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Heggem (US 1,935,027).

Regarding claims 1, 16, 17, 33: Heggem discloses a removable surface pack-off device that includes the following features:

- A housing (Figure 1) adapted to be mounted between the ends of an inner casing **11** and an outer casing **10** at the well surface.
- At least one fluid passage **17** disposed within the housing and being capable of passing fluid from a location outside the well to an annulus between the casings.
- A first pressure-activated seal **16** disposed between the inner casing and the housing.
- A second pressure-activated seal **16** disposed between the outer casing and the housing.

Regarding claims 2, 18: The first and second pressure-activated seals are not specifically disclosed as cup-type or lip seals but are disclosed as packing seals which are commonly lip seals.

Regarding claims 4, 16, 24, 33: The device includes a pair of retaining wings 27 mounted to an outer surface of the housing.

Regarding claims 5, 16, 25, 33: The device includes a pair of flanges 1 that are indirectly secured to an outer surface of the outer casing.

Regarding claims 7, 27, 33: The device includes a pair of retention bolts 4 mounted to the wings and flanges.

Regarding claims 9, 20: The first seal is located between an outer surface of the inner casing and an inner surface of the housing.

Regarding claims 10, 21: The second seal is located between an outer surface of the outer casing and an inner surface of the housing.

Regarding claims 12, 23: The first and second seals are held in place by a retaining nut 4.

Regarding claims 13, 30, 34: The device includes an inlet connector 18 attached to the housing.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148.

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 6 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heggem in view of Bielstein (US 2,799,476).

Heggem discloses all of the limitations of the above claim(s) except for the flanges forming two halves of a clamp that is held together by a pair of bolts.

Bielstein discloses a device similar to that of Heggem. Bielstein further discloses two flanges that form two halves of a clamp that is held together by a pair of bolts (Figure 2).

It would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have modified the device of Heggem so that the flanges formed two halves of a clamp that were held together by a pair of bolts as taught by Bielstein in order to have provided a means for forming the upper end of the housing while still allowing easy access to the internal portions of the housing for repair.

5. Claims 15, 32, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heggem in view of Biffle (US 3,965,987).

Heggem discloses all of the limitations of the above claim(s) except for the device including an eye hook mounted on the top of the housing.

Biffle discloses a device similar to that of Heggem. Biffle further teaches an eye hook **52** located on top of the housing.

It would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have modified the device of Heggem to include an eye hook as taught by Biffle in order to have provided a means for hoisting the device onto and off of the casing strings.

Allowable Subject Matter

6. Claims 3, 8, 11, 14, 19, 22, 28, 29, 31, and 35 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

7. In view of applicant's amendment, the objections to the drawings, the abstract, and the specification have been withdrawn.

8. Applicant's arguments filed May 8, 2006 have been fully considered but they are not persuasive. The applicant has argued that the annulus of Heggem is packed off with packing material and thus is incapable of passing fluid from a location outside of the well into an annulus formed between the inner and outer casings. Furthermore, the

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applicant has pointed out Heggem's disclosure that the fluid ports (17) are in fact "outlet ports," and therefore the applicant has argued that Heggem does not teach passing fluid *into* the ports.

The examiner respectfully disagrees with applicant's argument. While Heggem does teach that the fluid ports (17) are "outlet ports," that teaching does not in any way mean that the fluid ports are *incapable* of being used as inlet ports, because there is no structural element precluding the fluid ports from being used as inlet ports. In fact, the same could be said of the instant application. Although the applicant has stated that his device is used in reverse-circulation cementing, there are no structural elements precluding the device from being used in forward-circulation cementing. If the device were used in forward-circulation cementing, then the fluid ports (142) would be *outlet ports* rather than inlet ports as designated in the instant specification. Therefore, the examiner maintains that the fluid ports of Heggem are *capable* of functioning as inlet ports, and thus meet the limitations of the independent claims.

Furthermore, the examiner does not agree that Heggem's device is incapable of passing fluid from outside the casing into the annulus between the inner and outer casing. The examiner directs the applicant's attention to figure 3 of Heggem. Upon close inspection it is apparent that there is nothing obstructing the flow from the fluid passage (17) into the annulus in between the inner (11) and outer (10) casing. The examiner acknowledges the presence of packing material (31 – shown only in Figure 4), and the examiner further acknowledges that the packing material seals the space between the inner casing and outer casing. However, the *fluid passage* (17) is not

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separated from the annulus by the packing material. Therefore, the fluid passage of Heggem is capable of passing a fluid from a location outside of the well into an annulus formed between the inner and outer casings.

For all of these reasons, Heggem does teach all of the limitations of claims 1, 2, 4, 5, 7, 9, 10, 12, 13, 16-18, 20, 21, 23-25, 27, 30, 33, and 34.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert E. Fuller whose telephone number is 571-272-0419. The examiner can normally be reached on Monday thru Friday from 8:00 AM - 5:30 PM. The examiner is normally out of the office every other Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

06/28/2006
REF


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